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EXAMINER

EDWARDS, PATRICK L

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/087,406

Applicant(s)

SIMPSON ET AL.

Examiner

Patrick L. Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,14,17-26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,14,17-26 and 30 is/are rejected.
- 7) ☒ Claim(s) 1, 2, 5, 6, 14, 25, 26, and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-13-2006 has been entered.

Response To Arguments

2. Applicant's arguments have been fully considered, and many of the previous objections/rejections from the previous action have been obviated by applicant's amendments. However, these amendments have caused new problems which will be addressed below. Further, the previous art rejections will be applied as before.

Claim Objections

3. The follow quotations of 37 CFR § 1.75(a) provides the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

4. Claim 1, 2, 5, 6, 14, 25, 26, and 30 are objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

The metes and bounds of claim 1 are unclear as currently recited. After reading this claim, one has no idea what these steps are actually reciting. When reading this claim, we should keep in mind that this is a method claim, and the claim is therefore defined by its steps.

In the first step, we have a watermark service that sends a first network communication. We know that this first network communication "includes imaging servicing content representing a plurality of selectable watermark images". But we don't know where this first network communication is sent to.

In the second step, the watermark service receives a second network communication. We know that the second network communication "includes information at least indirectly related to the selection of a watermark image from the plurality of selectable watermark images". But we don't know where this second communication comes from. Furthermore, the examiner is unable to draw any meaningful scope around the term "information at least indirectly related to the selection of a watermark image". What exactly does this phrase mean? If something is at least indirectly related to the selection of a watermark image, does it follow that this something is at most directly related to the selection of a watermark image? If so, does this phrase then mean that the information is either indirectly or directly related to the selection of a watermark image? Also, what is the litmus test for determining whether information is directly related to the selection of a watermark image, or whether it is indirectly related to the selection of a watermark image? How can information be indirectly related to the selection of a watermark image? If

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a watermark vendor were to send a watermark consumer pictures of several watermarks and ask the consumer to select one, what information would the watermark consumer convey back to the vendor that would fall under the umbrella of information that is "indirectly related" to the consumer's selection of a watermark? If the consumer selects any watermark, how could the information conveyed back to the vendor be indirectly related to the watermark? What, then, would constitute a direct relationship?

In the final paragraph, the term "the selected watermark image" lacks antecedent basis in the claim. The claim does not require that there be a selected watermark image based on the current language. Rather, the claim simply requires "information at least indirectly related to the selection of a watermark image." This language does not require the selection of a watermark image because even if the consumer chose not to select an image, there would be some information relayed back to the watermark service that would be "at least indirectly related to the selection of a watermark image."

Regarding claim 25, there is no nexus between the preamble of the claim and its body. This claim is therefore indefinite in that it is unclear what statutory category this claim is intended to fall under.

A Note On Claim Interpretation:

The examiner's understanding of this claim is such that any watermarking service that added watermarks to a client's data would read on this claim. The watermark service presents possible images that can be placed on watermarks, the user selects an image, and then selected image is placed on some data that the user owns (e.g. an image). This sort of setup necessarily requires all the steps of the claim. This type of broad interpretation is reasonable because of the broad and ambiguous claim language.

Accordingly, these claims will be rejected using the previous rejection, and the applicant is invited to make amendments to the claim that would make it more clear and prevent it from being read on by old and well known systems.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 5, 6, 14, 25, 26, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For the reasoning behind this rejection, please refer to the rule 75 objection explained above.

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Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 25, 26, and 30 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The reasoning behind the 112(2) rejections to these claims is incorporated herein and causes the 101 problems. The preamble of claim 25 recites "a computer-readable medium storing computer readable instructions." The body of claim 25 recites some steps, but there is no nexus between the preamble of the claim and the body.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 5, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ha (Pub. No. US 2002/0032863 A1, hereinafter Ha) in view of Cox et al. (PN 6,253,323, hereinafter Cox).

Regarding Claim 1: Ha discloses a method of adding a watermark image to a composition, said method comprising:

- receiving a network communication selecting a watermark image [The watermarking unit (Figure 1, 14) receives a user's ID and user key from the database (Figure 1, 12) (p. 2, paragraph 0029, lines 7-10).], the watermark service (14) operating on a network server (internet, Figure 1, 30), the watermark service (14) being stored on a first network server (operator server, Figure 1, 10) and having access to a plurality of watermark images (user key) [The user key is a combination of alpha/numeric/alpha-numeric characters and therefore qualifies as an image (p. 2, paragraph 0024, lines 3-5). A user key is created for each user (p. 2, paragraph 0024, lines 1-3). It is obvious that multiple users would use the system, and therefore, there would be multiple user keys.];
- accessing a target composition (contents) that includes one or more graphic references [The web server (Figure 1, 11) accesses the contents located in the database (12) (p. 2, paragraph 0029, lines 3-4). The

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contents may be any form of digital multimedia, which include digital pictures and therefore graphics (p. 1 paragraph 0001, lines 1-3 and paragraph 0008).].

Ha does not expressly disclose the target composition being stored on a second network server. The contents, which represent the target composition, are stored in the database (12), which is part of the first server (10). However, it would have been obvious to store the contents in another database in another server connected to the internet (30). One would have been motivated to make this modification to improve security of the watermark images.

Furthermore, the database (12) is shown as being external from the watermarking unit (14), suggesting that the database (12) could be located in another server separate from the operator server (10), so long as it is accessible by the watermarking unit (14), web server (11), and authentication unit (13).

- Ha also does not disclose generating a watermark composition comprising the one or more graphic references of the target composition and a reference to the selected watermark image.

However, Cox discloses a set of associated stored electronic signal (Figure 1, 110, which represent the watermark composition) comprising a signal (130) referencing a remotely stored electronic document (representing the target composition) and a signal (120) referencing a remotely stored digital certificate (representing a watermark) (col. 4 lines 47-58).

It would have been obvious to one of ordinary skill in the art to modify Ha to modify the watermarked information so that it contains references to the contents and user keys, as taught by Cox. Storing the watermarked information in this form allows for increased flexibility within the system. For example, if a user key is changed after watermarking the contents, the watermarked information would still be valid since the reference would point to the more recent user key.

Regarding Claim 2: Ha discloses the method of claim 1, wherein receiving a network communication selecting a watermark image is accomplished with the aid of an imaging extension [It is inherent that an imaging extension is used to access the database (12) when the database contains digital images (p. 1, paragraph 0008).].

Regarding Claim 5: Cox discloses the method of claim 1, further comprising storing the watermark composition on a network. Cox discloses the object, which is the set of signals representing the watermark composition, being used on the Internet (col. 5 lines 7-9). Therefore, Cox teaches the watermark composition stored on the network.

However, Cox does not disclose the watermark composition store operating on the second network server.

Nevertheless, it would have been obvious to one of ordinary skill in the art that the modification of Ha with Cox would result in storing Cox's watermark composition on a database connected to Ha's Internet (30) and operator server (10). One would have been motivated to keep a record of all watermarked contents in a separate database for security purposes.

Regarding Claim 14: Ha discloses the method of claim 1, wherein the target composition (contents) is stored in a personal-imaging repository (database, Figure 1, 12) associated with the user [The contents are stored in the

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database (12) (p. 2, paragraph 0029, lines 1-4). The database (12) is associated with a user since the database's contents can only be requested by an authenticated user client (Figure 1, 20) (p. 2, paragraph 0028).].

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ha in view of Cox as applied to claim 5 above, and further in view of French et al. (PN 6,396,594, hereinafter French).

Regarding Claim 6: Cox discloses the watermark composition being web content, such as URLs (col. 5 lines 7-21). Neither Ha nor Cox discloses generating a hard-copy product. However, French discloses serving the combined watermark and print data to a remote service (Figure 5B, 530, printer hardware), and the remote service generates a hard-copy product using the watermark composition (col. 7 lines 10-16). It would have been obvious to one of ordinary skill in the art to connect a print server (Figure 1, 108) and printer device (Figure 1, 110) as taught by French to Ha's internet (Figure 1, 30). Furthermore, one would have been motivated to make this modification because often watermark compositions are used for display. For example, one may wish to print a watermarked photograph for display.

12. Claims 17-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ha in view of Cox and French.

Regarding Claim 17: Ha discloses a system for adding a watermark to a composition, comprising:

- A watermark service (watermarking unit, Figure 1, 14) coupled to a network (Internet, Figure 1, 30) and having access to imaging services content representing a plurality of selectable watermark images (user key) [The user key is a combination of alpha/numeric/alpha-numeric characters and therefore qualifies as an image (p. 2, paragraph 0024, lines 3-5). A user key is created for each user (p. 2, paragraph 0024, lines 1-3). It is obvious that multiple users would use the system, and therefore, there would be multiple user keys.]; and
- A computing device (user client, Figure 1, 20) coupled to the network (30), the computing device configured with a browser [It is inherent that the user client (20) has a browser for accessing the Internet (30).], wherein the browser is configured to receive the imaging-service content from the watermark service (Figure 2, step 205, p. 2, paragraph 0034).

Ha does not disclose enabling the user client to select the watermark from a plurality of watermarks. French discloses selecting a watermark from predefined watermarks (col. 6 lines 37-38). It would have been obvious to one of ordinary skill in the art to modify Ha to allow the user client (20) to select a watermark image in addition to the

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user key to be inserted into the contents. Furthermore, one would have been motivated to make this modification to provide increased copyright protection.

Ha also does not disclose obtaining a reference to the selected watermark image. Cox discloses using a watermark reference [The watermark reference is the arrow (Figure 1, 125) pointing to the digital certificate (Figure 1, 120).] integrated with a target composition [The target composition is the reference to object (Figure 1).], which includes one or more graphic references [The graphic reference is the arrow (125) pointing to the stored electronic document (130).] (col. 4 lines 47-58).

Ha also does not disclose initiating the watermark composition. However, Cox discloses the generation of a watermark composition [The watermark composition is the set of electronic signals (110)] comprising the reference to the watermark image (the arrow (125) pointing to digital certificate (120)) and the one or more graphic references (arrow (125) pointing to the stored electronic document (130)).

It would have been obvious to one of ordinary skill in the art to modify Ha's watermarking unit (14) to combine references to a watermark image with references to a graphic images to form the watermark composition. Furthermore, one would have been motivated to make this modification to increase the flexibility of the watermarking system, allowing changes to be made efficiently. For example, using references one could change a single watermark and effectively change the watermark on many images.

Regarding Claim 18: Ha as modified by Cox discloses the system of claim 17, wherein the reference to the selected watermark includes a reference to a textual watermark (user key) [The modification would result in Cox's watermark reference (Figure 1, arrow (125) pointing to the digital certificate (120)) pointing to a user key as taught by Ha. Ha teaches that this user key is a combination of alpha/numeric/alpha-numeric characters, and therefore is a textual watermark (p. 2, paragraph 0024, lines 3-5).].

Regarding Claim 19: Ha as modified by Cox discloses the system of claim 17, but neither expressly disclose the watermark being a graphic. However, French discloses the watermark property (210) containing a pointer to a selected graphic image (col. 4 lines 22-23). It would have been obvious to one of ordinary skill in the art to use a graphical design in place of Ha's user key. It is common in the art to use logos and similar graphics as watermarks for identifying ownership.

Regarding Claim 20: Ha discloses the system of claim 17, wherein the browser comprises an imaging extension [It is inherent that an imaging extension is used to access the database (12) when the database contains digital images (p. 1, paragraph 0008).].

Regarding Claim 21: Ha discloses the system of claim 17, further comprising:

- A service server (web server, Figure 1, 11) coupled to the network (Internet, Figure 1, 30) and a service (watermarking unit, Figure 1, 14), wherein the service server (11) receives data from the browser (inherent

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in user client, Figure 1, 20) [The web server (11) receives a request for transfer (Figure 2, step 203) from the browser inherent in the user client (20) (p. 2, paragraph 0028, lines 3-5).]

Regarding Claim 22: Ha does not disclose the data comprising resource device commands. However, French discloses a print server (Figure 1, 108), which receives print jobs from user units (Figure 1, 104a-104n) (col. 3 lines 23-26). These print jobs represent resource device commands. It would have been obvious to one of ordinary skill in the art to modify Ha to include a print server connected to the Internet (30) for printing the watermarked contents requested by the user client (20). One would have been motivated to make this modification because of the desirability for force printing of watermarks within enterprises as pointed out by French (col. 1 lines 55-62).

Regarding Claim 23: Ha does not disclose the data comprising a reference for accessing the watermark composition from a storage device. However, French discloses the user selecting a watermark from predefined watermarks (408) (col. 6 lines 37-38). Since the watermarks are predefined it is inherent that they are stored and therefore the selection is a reference to the location of the watermark in this inherent storage device. It would have been obvious to one of ordinary skill in the art to modify Ha's user client (20) to include French's user interface (402) to allow the user to select the watermark. Furthermore, it would have been obvious to make this modification because varying the watermarks used increases copyright protection.

Regarding Claim 24: French discloses the system of claim 22, wherein the resource device commands (print jobs) are configured to direct the creation of a hard-copy product [The print jobs are served by the print server (108) and printer device (110) thereby creating a hard-copy (col. 3 lines 23-26).].

Regarding Claim 25: Ha as modified by French and Cox discloses a computer-readable medium storing computer readable instructions for:

- Receiving imaging-service content representing a plurality of watermark images [See the analogous arguments of claim 17.];
- Enabling a user to select a watermark image from the plurality of watermark images represented by the imaging service content [See the analogous arguments of claim 17.];
- Obtaining a reference to a watermark image selected by the user [See the analogous arguments of claim 17.];
- Identifying one or more compositions designated for integration with the reference to the selected watermark image, each of the one or more compositions including one or more graphic references [See the analogous arguments of claim 17.];

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- For each of the one or more compositions, initiating the generation of a watermark composition comprising the reference to the watermark image and the one or more graphic references of that composition at least one target composition [See the analogous arguments of claim 5.]; and
- Initiating the storage of the one or more generated watermark compositions in a personal imaging repository [See the analogous arguments of claim 14.].

Regarding Claim 26: French discloses the computer-readable medium of claim 25, storing further instructions for:

- Redirecting the one or more watermark compositions (combined watermark and application printer ready data) to at least one service to generate a product [The print converter (520) delivers the combined watermark and application printer ready data to the printer (530), which generates a printed copy of the data (col. 7 lines 10-15).].

Regarding Claim 30: French discloses the computer-readable medium of claim 26, wherein the instructions for redirecting include instructions for redirecting a reference (pointer) to at least one of the one or more watermark compositions [The watermark delivered by the print converter (520) may be a pointer to a graphic image or text (col. 4 lines 22-23). A pointer is understood to be synonymous with a reference.]. French does not disclose the watermark composition residing within the personal imaging repository. Ha discloses storing the watermark composition in the personal imaging repository [See the analogous arguments of claim 14.]. It would have been obvious to one of ordinary skill in the art to connect French's print server (108) to Ha's Internet (30) thereby allowing the print server (108) to print watermark compositions stored in the personal imaging repository. One would have been motivated to make this modification to improve flexibility in printing various watermarks.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick L. Edwards whose telephone number is (571) 272-7390. The examiner can normally be reached on 8:30am - 5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella, can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patrick L. Edwards

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